

REMARKS

Claims 1-10 and 12-22 are pending in the application. With this Amendment, claims 8-10, 14 and 17 have been amended in order to correct the minor informalities noted by the Examiner on page 2 of the Office Action. Entrance of the Amendment is earnestly in order to place the claims in condition for allowance, or in better form for Appeal. Reconsideration of Applicant's claims in view of the arguments presented below is earnestly solicited.

Claims 8 and 9 have been amended to insert the word --attachment-- before the word "apparatus". Regarding claim 10, line 3, both terms "front" and "upright" are adjectives utilized to describe one section of the claimed container, therefore, where appropriate, the term has been defined as the container front upright section, see also claim 14. Claim 14 has also been amended as suggested by the Examiner to clarify that the back plate is connected to the container front upright section. The term "rail" in claim 17 has been replaced with the term --side member-- commensurate with the description in claims which claim 17 depends from.

Accordingly, it is believed that all of the claim objections have been attended to.

Claims 1, 2, 8, 10, 12 and 15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Freedman et al. (U.S. Patent No. 6,398,302). The Examiner states that Freedman discloses an attachment apparatus comprising a guide member and a connector member as claimed.

It is respectfully submitted that the preamble of independent claims 1 and 15 claim an attachment apparatus for a container and a container adjustable attachment apparatus. Independent claim 10 claims a transportable container having the height adjustable attachment apparatus connected thereto. The Applicant has previously argued the limitation with respect to the preamble of claims 1 and 15 and, therefore, the container limitation is indeed part of the claims. Section 2111.02 of the MPEP discusses the effect of the preamble on patentability. Therein it is stated "A claim preamble has the import that the claim as a whole suggests for it." See *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life,

meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." See *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Moreover, in Section I, it is further stated: "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). As set forth in Section II, during examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). As is the case in the present invention, Applicant's preamble limitations set forth in independent claims 1 and 15 define over the cited prior art of Freedman and Gohman which respectfully relate to child safety seats and a tool for removing roofing material. Accordingly, Applicant's preamble provides context for claim construction and consideration thereof, as required by the MPEP and case law, is respectfully requested.

As described in the specification on page 8, first and second paragraphs, the container of the present invention is adapted to be transported by a truck or other transport vehicle and is used to store various materials or items including, but not limited to, waste materials including residential, commercial and industrial refuse or debris, bulk material, and finished product, parts or components. Containers of the invention are known in the art as roll-on, roll-off containers, dumpsters, receiver boxes, or the like.

The Freedman reference cannot anticipate nor teach a container comprising an attachment apparatus as set forth in claim 10, nor an attachment apparatus for a container as claimed in claims 1 and 15. The Freedman reference relates to an adjustable child-restraint seat for a vehicle comprising a seat shell, a harness panel, and a restraint harness. The harness panel 5 including anchor point shaft 4 and slot panel 6 is connected to top seat portion 1 of the child-restraint seat. Accordingly, Freedman cannot anticipate nor teach an attachment apparatus for a container, nor a container comprising attachment apparatus.

Moreover, as illustrated in FIG. 1 and more particularly in FIG. 3, harness panel 5 is positioned outwardly of the slot panels 6 and behind top seat portion 1 and, therefore, the anchor-point shaft 4 is substantially inaccessible and cannot be adapted to be engaged by a hook or attachment element of a container retrieving hoist mechanism of a transport vehicle so the attachment apparatus can be moved as claimed in the independent claims.

Also, independent claims 1, 10 and 15 claim that the slotted track has a height adjustment slot and at least two arm slots connected to and extending outwardly i.e. away from the container and back of the guide members, as shown in the drawings of the present invention, a predetermined distance from the height adjustment slot. As illustrated in FIGS. 1 and 2 of Freedman, the slots of slot panel 6 extend inwardly towards the seat. Accordingly, Freedman cannot anticipate nor teach Applicant's claimed limitations. Even if the shaft 4 was accessible from the rear of the Freedman seat, the shaft would be pulled outward towards the back side of the seat into the height adjustment slot and moved to the top outermost portion of the slot! This would render Applicant's device inoperative! Accordingly, one of ordinary skill in the art would not be motivated to consider the Freedman reference.

It is respectfully submitted that the Examiner has not proved a *prima facie* case of obviousness with respect to the Freedman reference. As stated by the Federal Circuit, "under 35 U.S.C. §102, anticipation requires that the prior art reference must be enabling, thus placing the allegedly disclosed matter in possession of the public", see *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986). The Federal Circuit has added that anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosed, as viewed by a person of ordinary skill in the field of the invention." (See *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).)

It is respectfully submitted that one of ordinary skill in the art in the field of hauling or containers would not look to the child seat industry for a disclosure as to how to improve a container adapted to be transported by a transport vehicle. Freedman does not describe Applicant's claimed attachment apparatus for a container as claimed in

claims 1 and 15 nor Applicant's claimed container including the apparatus set forth in independent claim 15.

The Freedman reference description does not enable a person of ordinary skill in the art to comprehend the invention, much less make it. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claim", see *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

Claims 1, 2, 8, 10, 12 and 15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Gohman (U.S. Patent No. 6,125,720). The Examiner states that Gohman discloses an attachment apparatus comprising a guide member and a connector member.

Again, as respectfully argued hereinabove with relation to the Freedman reference, Gohman teaches a roofing material and roofing fastener removal tool comprising a handle attached to a blade, wherein the handle is adjustable relative to the blade that cannot anticipate, nor teach or suggest Applicant's claimed attachment apparatus for a container (claims 1 & 15) or with an attachment apparatus (claim 10) to which the Applicant's claims are limited. Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to the Gohman reference. The guide member of Gohman having at least two side rails 66 and 68 is attached to a blade 120 including end 122 and second portion 190. Blade 120 cannot be considered a container and one of ordinary skill in the art would not be motivated to consider the Gohman reference.

As blade 190 must be considered the container, Gohman cannot anticipate, nor teach or suggest Applicant's claimed slotted track in independent claims 1, 10 and 15 having a height adjustment slot and at least two arm slots connected to and extending outwardly a predetermined distance from the height adjustment slot i.e. away from the container and back of the guide member. Again, even if a hook or attachment element of a container retrieving hoist mechanism of a transport vehicle was connected to "connector member" 112, connector member 112 would be pulled out of the arm slot and moved into the height adjustment slot 90 towards the upper outer edge thereof.

This would render Applicant's device inoperative! One of ordinary skill in the art would be not led to consider the Gohman reference, absent impermissible hindsight.

The Examiner states with respect to Applicant's connector member, as claimed in independent claims 1, 10 and 15, being adapted to be engaged by a hook or attachment element of a container retrieving hoist mechanism of a transport vehicle so that the attachment apparatus can be moved is a functional limitation. As stated by the CCPA:

"We take the characterization "functional", as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it *does* rather than by what it *is* (as evidenced by specific structure or material, for example). In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical *necessity* for the use of functional language." (See *In re Swinehart*, 439 F.2d 210, 169 USPQ 226, 228-29 (C.C.P.A. 1971).)

Accordingly, it is respectfully submitted that the Examiner is not permitted to dissect the claim and remove the functional limitation when determining anticipation. There is ample precedence to establish that functional limitations are appropriate in claims and should be afforded patentable weight by the Examiner for determining anticipation, see *In re Ludtke*, 441 F.2d 660, 169 USPQ 563, 566 (C.C.P.A. 1971). Functional limitations are to be given patentable weight even if it is only these limitations that distinguish over the prior art. Applicant's claimed functional limitations are neither an express or inherent characteristic of the cited prior art. As indicated hereinabove, the references relate to the field of child safety seats and roofing material and roofing fastening removal tools. Indeed, Applicant's claimed functional limitation further distinguish the claims of the present invention from the cited references in addition to the above-described structural differences.

See also MPEP §2173.05(g). Applicant's claims regarding a container containing an attachment apparatus as well as an attachment apparatus for a container fully set forth definite boundaries on which patent protection is sought. Applicant's claimed

functional language serves to precisely define the present structural attributes of interrelated component parts of the claimed assembly.

Accordingly, numerous structural and functional limitations that can neither be anticipated, nor taught or suggested by the Freedman or Gohman references are set forth within Applicant's independent claims.

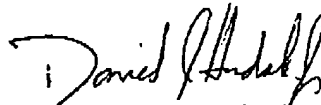
Claims 17-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Freedman et al. in view of Burleigh et al. (U.S. Patent No. 4,790,601). Claims 21 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Freedman et al. in view of Miller (U.S. Patent No. 4,813,739).

It is respectfully submitted that the Burleigh and Miller references cannot add any further teachings or suggestions that would render the present invention obvious in view of the cited references. Both Miller and Burleigh further relate to components for child safety seats and one of ordinary skill in the art would not be led in the direction that the Applicant has taken.

It is respectfully submitted that the claims are in condition for allowance and a notice of such is earnestly solicited. Should the Examiner have any questions or concerns regarding this response, a telephone call to the undersigned would be greatly appreciated.

Respectfully submitted,

HUDAK, SHUNK & FARINE CO. L.P.A.



Daniel J. Hudak, Jr.
Registration No. 47,669

DJHjr/js
2020 Front St., Suite 307
Cuyahoga Falls, Ohio 44221
330-535-2220

Attorney Docket No. ESTES-A-CIP